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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,697	10/06/2000	Walter W. Collins	KSW 312RI	1037
7590 11/17/2004				
CHARLES H. DeVOE, ESQ. KOLISCH, HARTWELL, DICKINSON, McCORMACK & HEUSER 520 S.W. YAMHILL STREET, STE. 200 PORTLAND, OR 97204			EXAMINER DEXTER, CLARK F	
			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/680,697

Applicant(s)

COLLINS, WALTER W.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31,33,34,36,37,45 and 47-50 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-31,33,34,36,37,45 and 47-50 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 23, 2004 has been entered.

### ***Claim Objections***

2. Claims 30, 31 and 33 are objected to because of the following informalities:

In claim 30, line 7, and in claim 33, line 6, it is respectfully submitted that the use of "interposed" is awkward, and it appears that a word such as --between-- should be inserted after "interposed" or the like. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

3. Claims 12-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 3724

The original disclosure does not appear to provide support for the first end of the plunger being "free from lateral movement relative to the handle" as now set forth in claim 12, lines 12-14. Rather, support is provided for a plunger having a first end that moves laterally as shown, for example, in Figures 4B-C.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

4. Claims 12-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, lines 12-14, the recitation "wherein said first end is free from lateral movement relative to said handle, as said blade moves between said retracted and extended positions" is vague and indefinite as to what is being set forth.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12 and 19-21, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by French publication 1.069.862 (hereafter FP '862).

FP '862 discloses a folding knife with every structural limitation of the claimed invention as best understood from the claims including a handle (e.g., 1, 2) defining a blade cavity; a blade (e.g., 6) having a blade pivot (e.g., 7) connected to the first end of the handle; a longitudinally extending plunger (e.g., 14, 15); wherein the first end of the plunger is slidably and pivotably connected to the handle (e.g., it is slidable between components 1 and 3, and pivotable as shown in Figures 3-4), and the second end (e.g., 14) of the plunger is pivotally connected to the first end of the blade.

7. Claims 23, 29 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown, pn 1,864,011.

Brown discloses a folding knife with every structural limitation of the claimed invention including a blade (e.g., 1), and a plunger (e.g., 3) including a spring (e.g., 8), the plunger pivotally connected to the blade (e.g., via 11), and the spring adapted to perform the recited function including causing the spring to assist opening of the blade when the blade is pivoted from the retracted position toward the extended position beyond the intermediate point.

### ***Claim Rejections - 35 USC § 102/103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3724

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 28 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown, pn 1,864,011 (Brown '011).

Brown '011 discloses a folding knife with every structural limitation of the claimed invention including a clevis as claimed including pin (e.g., 13).

In the alternative, if it is argued that Brown '011 lacks the second end of the plunger including a clevis having a pin pivotally connected to the first end of the blade, the Examiner takes Official notice that such rotatable connections are old and well known in the art and provide various known benefits including providing a sturdy, unbiased connection for relative rotation between two components. Therefore, it would have been obvious to one having ordinary skill in the art to provide a clevis on the second end of the plunger for the well known benefits including those described above.

### ***Claim Rejections - 35 USC § 103***

#### **Obviousness Rejections Based on French Patent 1.069.862**

10. Claim 13, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862) in view of Thompson et al., pn 5,131,149 (Thompson '149).

FP '862 lacks the first end of the blade having an extension with a plurality of ridges thereon. Thompson '149 discloses a blade having such a plurality of ridges on a first end of the blade and teaches that it facilitates one-handed actuation of the blade. Therefore, it would have been obvious to one having ordinary skill in the art to provide

Art Unit: 3724

an extension having a plurality of ridges on the blade of FP '862 for the benefits taught by Thompson '149 including that described above.

11. Claim 16, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862) in view of Seber et al., pn 5,546,662.

FP '862 lacks a belt clip connected to the handle adjacent one of the sides of the handle. Seber discloses such a clip for attachment to a belt. Such an attachment provides various obvious and well known benefits including freeing the hands for use while still maintaining possession of the knife and while providing easy and quick access to the knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide a belt clip on the knife of FP '862 for the obvious and well known benefits including those taught by Seber as described above.

12. Claim 17, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862).

FP '862 lacks the second end of the plunger including a clevis having a pin pivotally connected to the first end of the blade. However, the Examiner takes Official notice that such rotatable connections are old and well known in the art and provide various known benefits including providing a sturdy, unbiased connection for relative rotation between two components. Therefore, it would have been obvious to one having ordinary skill in the art to provide a clevis on the second end of the plunger for the well known benefits including those described above.

Art Unit: 3724

13. Claim 18, as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent 1.069.862 (FP '862) in view of Brown, pn 1,701,027.

FP '862 lacks the first end of the blade having an arcuate slot, and the handle including a pin carried in the arcuate slot. However, the Examiner takes Official notice that such configurations are old and well known in the art as evidenced by Brown and provide various known benefits including providing stability to the knife, and particularly additional stability between the knife and the handle during opening and closing of the knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide the first end of the blade having an arcuate slot, and the handle including a pin carried in the arcuate slot for the well known benefits including those described above.

Obviousness Rejections Based on Brown, pn 1,864,011

14. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011) in view of Thompson et al., pn 5,131,149 (Thompson '149).

Brown '011 lacks the first end of the blade having an extension with a plurality of ridges thereon. Thompson '149 discloses a blade having such a plurality of ridges on a first end of the blade and teaches that it facilitates one-handed actuation of the blade. Therefore, it would have been obvious to one having ordinary skill in the art to provide an extension having a plurality of ridges on the blade of Brown '011 for the benefits taught by Thompson '149 including that described above.



15. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011) in view of Seber et al., pn 5,546,662.

Brown '011 lacks a belt clip connected to the handle adjacent one of the sides of the handle. Seber discloses such a clip for attachment to a belt. Such an attachment provides various obvious and well known benefits including freeing the hands for use while still maintaining possession of the knife and while providing easy and quick access to the knife. Therefore, it would have been obvious to one having ordinary skill in the art to provide a belt clip on the knife of Brown '011 for the obvious and well known benefits including those taught by Seber as described above.

16. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, pn 1,864,011 (Brown '011).

Brown discloses a folding knife with almost every structural limitation of the claimed invention including a blade (e.g., 1), and an elongate, force-transmitting spring (e.g., 8) that performs the recited function(s), and a plunger (e.g., the portion to which the lead line for numeral 3 contacts). Brown lacks the spring operating in the claimed direction; that is, a spring that exhibits the decrease in effective length as the blade is moved from one of the stowed and deployed conditions toward an intermediate point, and an increase in effective length as the blade is moved from the intermediate point toward the other conditions. However, it is old and well known in the art that springs operating in tension are equivalent to springs operating in compression, particularly since such springs are well known equivalents. Therefore, it would have been obvious

Art Unit: 3724

to one having ordinary skill in the art to simply change the type of the spring that operates in tension to a spring that operates in compression.

**Recapture (MPEP 1412.02)**

17. Claims 12-31, 33, 34, 36, 37, 45 and 47-50 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *Pannu v Storz Instruments*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. For example, none of claims 12-31, 33, 34, 36, 37, 45 and 47-50 have limitations directed to the key limitations added or argued in the original application to define over the prior art; specifically, the key limitations of the pivotal connector or the sleeve (which is a different term used to refer to the pivotal connector). Thus, these claims have the same or broader scope as compared to original claims 1 and 11 of the parent application. Further, none of the claims contains a substitute or replacement limitation that is related, but narrower to or broader than, at least one of the key limitations.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

### ***Response to Arguments***

18. Applicant's arguments filed August 23, 2004 have been fully considered but they are not persuasive. Regarding applicant's arguments regarding the recapture rejection, it is respectfully submitted that at least one limitation was omitted and was not replaced by another limitation that is related to the subject matter previously surrendered by applicant. Applicant is invited to contact the Examiner to further discuss any of the outstanding issues.

### ***Offer to Surrender Original Patent (MPEP 1416)***

19. Applicant's offer to surrender the original patent is acknowledged. Applicant is reminded that the original patent, or a statement as to the loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

### ***Claim Rejections - Defective Oath/Declaration***

20. Claims 1-31, 33, 34, 36, 37, 45 and 47-50 are rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251; specifically because there is no error within the meaning of 35 U.S.C. 251. See 37 C.F.R. 1.175.

Art Unit: 3724

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can be reached Monday through Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cf  
November 12, 2004